

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Richard LODGE, et al

Attorney Docket No.
9-13528-77US

Serial No: 09/489,929

Group Art Unit: 2685

Filed: January 24, 2000

Examiner: Pablo N. Tran

For: PACKET DATA TRAFFIC CONTROL FOR CELLULAR WIRELESS
NETWORKS

Assistant Commissioner for Patents
Washington, D.C. 20231

BOX -- Petitions

Sir:

PETITION UNDER 37 C.F.R § 1.181

Pursuant to 37 C.F.R. § 1.181(a)(3) Applicant hereby petitions to invoke the supervisory authority of the Commissioner to reassign the above-noted application to a different examiner within the group. Facts and arguments in support of Applicant's petition are as follows:

As an initial matter, a review of the prosecution history in this case is instructive:

- Non-Final Office Action mailed November 19, 2001 (Paper 4) - claims 1-2, 21-22 and 41-42 rejected under 35 U.S.C. § 102(b), as anticipated by United States Patent No. 5,636,230 (Marturano et al.); and claims 3-20, 23-40, and 43-54 rejected under 35 U.S.C. § 103, as unpatentable over Marturano et al. in view of United States Patent No. 6,201,971 (Purnadi et al.)
- Applicant's Response filed February 28, 2002: claims 11, 12, 31 and 32 amended, and arguments in rebuttal of Examiner's rejections submitted.

- Non-Final Office Action mailed May 22, 2002 (Paper 6) - claims 1-2, 21-22 and 41-42 rejected under 35 U.S.C. § 102(b), as anticipated by Marturano et al.; claims 3-18, 23-38, and 43-52 rejected in view of Marturano, but still without specifying the grounds of such rejection. Specifically, the Examiner did not indicate whether his rejection was under 35 U.S.C. § 102 or § 103; and claims 19-20, 39-40, 53-54 objected to as being dependent on a rejected base claim.
- Applicant's Response filed August 22, 2002: claims 1, 2, 14, 20, 21 and 41 amended, and arguments in rebuttal of Examiner's rejections submitted.
- Final Office Action Mailed November 4, 2002 (Paper 8): The Examiner rejected Applicant's arguments presented in the amendment filed on August 21, 2002; amendment filed on August 21, 2002 under 35 USC § 132 objected to as introducing new subject matter; previous rejections of claims 1-2, 21-22 and 41-42 under 35 U.S.C. § 102(b), as being anticipated by Marturano et al. maintained; previous rejection of claims 3-18, 23-38, and 43-52 in view of Marturano maintained, but still without specifying the grounds of such rejection; claims 19-20, 39-40, 53-54 indicated as allowable
- Applicant's response and Notice of Appeal filed February 4, 2003: claims 6, 9, 14, 15, 21, 26, 29, 35, 41, 47 and 51 amended, and arguments in rebuttal of Examiner's rejections submitted
- Non-Final Office Action mailed February 26, 2003 (Paper 11): claims 1-4, 6-13, 14-18, 21-24, 26-32, 34-38, 41-44, 46-48 and 50-52 rejected under 35 U.S.C. § 102(b), as anticipated by United States Patent No. 5,535,429 (Bergenlid et al.); claims 5, 25 and 45 rejected under 35 U.S.C. § 103(a), as being unpatentable over Bergenlid et al.; and claims 19-20, 39-40 and 53-54 indicated as allowable.
- Applicant's response filed May 26, 2003: claims 1, 18, 21 and 41 amended, and arguments in rebuttal of Examiner's rejections submitted

- Final Office Action Mailed August 22, 2003 (Paper 13): claims 1-18, 21-38 and 41-52 rejected under 35 U.S.C. § 103(a), as being unpatentable over *Bergenslid et al.* in view of United States Patent No. 5,507,006 (*Knight*); and claims 19-20, 39-40 and 53-54 indicated as allowable.
- Applicant's response and Notice of Appeal filed October 22, 2003: no claims amended, arguments in rebuttal of Examiner's rejections submitted
- Advisory Action mailed November 19, 2003 (paper 16)
- Appeal Brief Filed December 19, 2003;
- Non-Final Office Action mailed March 12, 2004 (Paper 18): claims 1, 6, 21 and 26 rejected under 35 U.S.C. § 102(b), as being unpatentable over United States Patent No. 5,383,221 (*Akita et al.*); claims 2-5, 7-9, 13-18, 22-25, 27-29, 33-38, 41-47 and 49-52 rejected under 35 U.S.C. § 103(a), as being unpatentable over *Akita et al.*; and claims 10-12, 19-20, 30-32, 39-40, 48 and 53-54 indicated as allowable;
- Applicant's response filed June 14, 2004: claims 1 and 21 amended, and arguments in rebuttal of Examiner's rejections submitted
- Non-Final Office Action mailed August 11, 2004 (Paper 20): claims 1-9, 13-18, 21-29, 33-38, 41-47 and 49-52 rejected under 35 U.S.C. § 103(a), as being unpatentable over *Akita et al.* in view of United States Patent No. 6,765,889 (*Ludwig*); and claims 10-12, 19-20, 30-32, 39-40, 48 and 53-54 indicated as allowable.
- Applicant's response filed December 10, 2004: no claims amended, arguments in rebuttal of Examiner's rejections submitted
- Final Office Action mailed May 31, 2005: claims 1-9, 13-18, 21-29, 33-38, 41-47 and 49-52 rejected under 35 U.S.C. § 103(a), as being unpatentable over *Akita et al.* in view of *Ludwig*; and claims 10-12, 19-20, 30-32, 39-40, 48 and 53-54 indicated as allowable

- Notice of Appeal and Pre-Appeal Brief Request for Review filed November 30, 2005;
- Notice of Panel Decision from Pre-Appeal brief Review Mailed February 10, 2006: Rejections withdrawn;
- Non-Final Office Action mailed April 20, 2006: claims 1-9, 13-18, 21-29, 33-38, 41-47 and 49-52 rejected under 35 U.S.C. § 103(a), as being unpatentable over United States Patent No. 6,173,184 (Kikuchi et al) in view of United States Patent No. 5,546,464 (Raith et al); and claims 10-12, 19-20, 30-32, 39-40, 48 and 53-54 indicated as allowable.

Thus it will be seen that the Applicant has been subjected to no less than nine office Actions rejecting one or more claims, of which fully three Actions have been "Final". In every case, the Examiner's "Final" rejections have been subsequently withdrawn, and the prior art relied upon by the Examiner abandoned in favour of new prior art references.

As pointed out in Applicant's Notice of Appeal and Pre-Appeal Brief Request for Review filed November 30, 2005, the Examiner's claim rejections have consistently been based on assertions regarding the teachings of the various cited references, which assertions are explicitly contradicted by the passages relied upon by the Examiner. It should be noted that this is not merely a matter of interpreting the meaning of a prior art teaching, or the scope of a claim. Rather, throughout the prosecution history of this case, Applicant has repeatedly been placed in a position of responding to (and on three occasions requesting an Appeal from) Examiner's rejections which are based on passages of the prior art that explicitly state the exact opposite of what the Examiner has alleged.

The non-final Office Action mailed April 20, 2006 represents a continuation of this pattern, but with prejudice, because the Examiner has dispensed with any effort to apply the prior art in favour of merely duplicating his arguments from the Final Action mailed May 31, 2005 but with the earlier references to Akita et al. and Ludwig replaced by references to Kikuchi et al and Raith et al, respectively. No new issues of patentability have been raised by the Examiner by way of this substitution of references.


For example, it will be noted that in both actions, the Examiner's primary reference (Akita in the Final Action of May 31, 2005, and Kikuchi et al in the Non-final action of April 20, 2006) teach systems in which a cellular handset detects when its link with the base station has become degraded, and responds by triggering a hand-off procedure (that is, attempting to set up a new link to a new base station). While there are differences between the Akita and Kikuchi teachings, none of these differences are relevant to the claims of the present application, and the Examiner makes no effort to argue otherwise. Similarly, the Examiner's secondary references in each Action (Ludwig and Raith et al) teach methods implemented in a base station, and are cited for that purpose, but otherwise offer no teaching of any relevance to the present invention, and provide no rational basis (much less motivation) for combination with the primary reference. As such, while the Examiner has cited two new references, he has failed to raise any new issues of patentability, and thus has failed to advance prosecution of the application.

Applicant acknowledges that the specific rejections raised by the Examiner are properly appealable, and therefore do not, in themselves, provide grounds for intervention by the Commissioner. However, Applicant believes that the Examiner's continuing failure to cite relevant prior art and/or to otherwise materially advance the prosecution of the application has unjustly denied the Applicant of its right to a fair examination of the application on the merits. An endless cycle of Non-final Actions leading to a Final Action that subsequently is withdrawn on Appeal only to reopen prosecution with a new Non-Final Action, cannot serve as a substitute for proper examination on the merits. Continuance of this pattern is believed to be unjust, and warrants re-assignment of the present application to a different Examiner for further prosecution on the merits. Accordingly, such action is courteously solicited.

Applicant further respectfully requests an oral hearing with the Director to discuss any questions or concerns that the Director may have with respect to any of the issues raised by this Petition.

If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this petition, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 19-5113.

Respectfully submitted,


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